

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF MISSOURI
EASTERN DIVISION**

ROBERT E. MORLEY, JR., et al.

Plaintiffs,

v.

SQUARE, INC., et al.,

Defendant.

Case No. 4:14-cv-00172 -SNLJ

SQUARE, INC., et al.,

Plaintiffs,

v.

REM HOLDINGS 3, LLC,

Defendant.

**Case No. 4:10-cv-02243-SNLJ
CONSOLIDATED**

JOINT NOTICE REGARDING STATUS OF PATENTS

Pursuant to the Court's request, Plaintiffs Robert E. Morley, Jr. and REM Holdings 3, LLC (hereinafter "Plaintiffs") and Defendants Square, Inc.; Jack Dorsey; and James McKelvey, Jr. (hereinafter "Defendants") submit the attached Joint Notice Regarding Status of Patents. The list below includes the status of IPRs and/or re-exams of United States Patents that are subject to claims in either the 4:14-cv-00172 action or the 4:10-cv-02243 action.

Patents Assigned to Square.

The following United States patents are subject to Dr. Morley's request to correct inventorship pursuant to Counts 10 and 11 of the -00172 action, both of which are stayed.

1. U.S. Patent 8,231,055 (the "'055 patent"). To date there has been no IPR or re-exam filed or pending against the '055 patent. The claims of the '055 are issued and are not subject to any claim of invalidity.
2. U.S. Patent 8,235,287 (the "'287 patent"). To date there has been no IPR or re-exam filed or pending against the '287 patent. The claims of the '287 are issued and are not subject to any claim of invalidity.
3. U.S. Patent 8,302,860 (the "'860 patent"). To date there has been no IPR or re-exam filed or pending against the '860 patent. The claims of the '860 are issued and are not subject to any claim of invalidity.
4. U.S. Patent 8,413,901 (the "'901 patent"). To date there has been no IPR or re-exam filed or pending against the '901 patent. The claims of the '901 are issued and are not subject to any claim of invalidity.
5. U.S. Patent 8,500,018 (the "'018 patent"). To date there has been no IPR or re-exam filed or pending against the '018 patent. The claims of the '018 are issued and are not subject to any claim of invalidity.
6. U.S. Patent 8,534,546 (the "'546 patent"). To date there has been no IPR or re-exam filed or pending against the '546 patent. The claims of the '546 are issued and are not subject to any claim of invalidity.

7. U.S. Patent 8,571,989 (the “’989 patent”). To date there has been no IPR or re-exam filed or pending against the ’989 patent. The claims of the ’989 are issued and are not subject to any claim of invalidity.
8. U.S. Patent 8,573,487 (the “’487 patent”). To date there has been no IPR or re-exam filed or pending against the ’487 patent. The claims of the ’487 are issued and are not subject to any claim of invalidity.
9. U.S. Patent 8,573,489 (the “’489 patent”). To date there has been no IPR or re-exam filed or pending against the ’489 patent. The claims of the ’489 are issued and are not subject to any claim of invalidity.
10. U.S. Patent 8,584,956 (the “’956 patent”). To date there has been no IPR or re-exam filed or pending against the ’956 patent. The claims of the ’956 are issued and are not subject to any claim of invalidity.
11. U.S. Patent 8,602,305 (the “’305 patent”). To date there has been no IPR or re-exam filed or pending against the ’305 patent. The claims of the ’305 are issued and are not subject to any claim of invalidity.
12. U.S. Patent 8,612,352 (the “’352 patent”). To date there has been no IPR or re-exam filed or pending against the ’352 patent. The claims of the ’352 are issued and are not subject to any claim of invalidity.

Patents Assigned to REM.

The following United States patent is asserted against Square pursuant to Count 4 of the -00172 action, which is stayed.

1. U.S. Patent 8,584,946 (the “’946 patent”). Square petitioned for an Inter Partes Review (IPR) on December 31, 2013. Oral argument before the PTAB was heard on

March 12, 2015. On July 7, 2015, the PTAB issued a Final Written Decision holding that claims 1, 2, 6, 7, and 10-17 were shown by Square to be unpatentable and claims 3-5, 8, and 9 were not proven by Square to be unpatentable. Square requested a rehearing on August 6, 2015, and the parties are awaiting the Board's decision regarding this request.

Dr. Morley's Statement Regarding the '946 patent:¹ Estoppel under 35 U.S.C. § 315(e)(2) attached on July 7, 2015 when the PTAB issued its Final Written Decision.

The following United States patent is asserted against Square pursuant to Counterclaim 2 of the -02243 action, which is stayed.

2. U.S. Patent 7,810,729 (the "'729 patent"). Square petitioned for re-examination of the '729 patent on May 10, 2011. On March 28, 2014, the PTAB, acting as a review panel, issued its opinion finding all issued claims to be unpatentable. On July 7, 2015, the PTAB denied Patent Owner's motion for reconsideration. On September 9, 2015, Dr. Morley filed a notice of appeal with the Federal Circuit.

Square's Statement Regarding the '729 patent:² Absent reversal by the Federal Circuit, the PTO will issue a Reexamination Certification canceling all claims issued for the '729 patent claims, rendering all causes of action in the -00243 action related to the '729 patent precluded or moot.

¹ Square does not join in this statement.

² Dr. Morley does not join in this statement.

The following United States patent is asserted against Square pursuant to Counterclaim 3 of the -02243 action, which is stayed.

3. U.S. Patent 7,896,248 (the “’248 patent”). Square petitioned for re-examination of the ’248 patent on May 10, 2011. On April 3, 2012, an Action Closing Prosecution of the re-examination was mailed finding claims 1-13 to be unpatentable, with claims 14-20 found to be patentable. On March 31, 2014, the PTAB, acting as a review panel, issued its opinion finding all issued claims to be unpatentable, including new grounds of rejection on claims 14-20. On November 10, 2014, the PTAB remanded the case to the examiner. Subsequently, REM amended claims 15-18 and 20 to add new limitations, and REM cancelled claim 17. As of August 6, 2015, claims 14-16 and 18-20 are awaiting consideration at the PTAB.

The following United States patent is asserted against Square pursuant to Counterclaim 4 of the -02243 action, which is stayed.

4. U.S. Patent 7,918,394 (the “’394 Patent”). Square petitioned for re-examination of the ’394 patent on May 10, 2011. On July 1, 2011, an Office action was mailed. Dr. Morley did not respond to the Office action. On January 17, 2012, An Inter Partes Reexamination Certification issued canceling all claims issued for the ’394 patent.

Square's Statement Regarding the '394 patent:³ All causes of action in the -00243 action related to the '394 patent are now precluded or moot.

Dated: September 18, 2015

Respectfully submitted,

³ Dr. Morley does not join in this statement.

CALDWELL CASSADY & CURRY

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on September 18, 2015, the foregoing was filed electronically with the Clerk of Court to be served by operation of the Court's electronic filing system upon all counsel of record.

/s/ Bradley W. Caldwell

Bradley W. Caldwell